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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,765	02/23/2004	Kenji Ono	04284.0781-01	6175
22852	7590	05/13/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			PAULA, CESAR B	
		ART UNIT		PAPER NUMBER
				2178

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/782,765	ONO ET AL.	
	Examiner	Art Unit	
	CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 February 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 17-20 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 17-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 February 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152..

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 09/016,488.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application, IDS, and preliminary amendment filed on 2/23/2004.

This action is made Non-Final.

2. In the amendment, claims 1-16 have been canceled. Claims 17-20 have been added. Claims 17-20 are pending in the case. Claim 17 is an independent claim.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 2/23/2004 has been entered, and considered by the Examiner, except for the references that are crossed out in the PTO-1449, due to missing a copy of such references.

Priority

4. Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged. This application is a continuation of application 09/016,488, now patent 6,742,163, filed on 1/30/1998.

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5. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 9-019393 filed in Japan on 1/31/1997, which papers have been placed of record in the file.

Drawings

6. The drawings filed on 2/23/2004 have been accepted by the Examiner.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 17-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,742,163 B1(same assignee, and inventors), hereinafter 163, in view of Borovoy et al, hereinafter Borovoy. (Pat.# 5,873,107, 2/1999, filed on 3/1996).

Regarding independent claim 1, 163 teaches all the limitations, with the exception of

transmitting a retrieve request, to a plurality of servers; a merging module configured to generate a ranking of the plurality of retrieved documents; and an abstract creation module for: creating a plurality of abstracts, each corresponding to one of the plurality of documents included in the ranking. However, Borovoy teaches submitting a document query to a collection of documents, such as web pages available over the Internet-- *retrieve request*, to a plurality of servers. Documents retrieved are also ranked with a relevance ranking-- *generate a ranking of the plurality of retrieved documents* (col. 3, lines 40-47, col. 4, lines 7-12). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine 163, and Borovoy to access multiple servers over the Internet, and relevance ranked those documents, because this would provide the user with a larger pool of documents, and greater contextual cognitive information as to the most relevant of the retrieved documents.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reese (Pat. # 6,374,237).

II. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The Examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

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Any response to this Action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER

4/29/05